

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: M. Michael Pitts, Jr. et al.

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EXAMINER: William T. Leader

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ART UNIT: 1742

CONFIRMATION NO.: 2055

APPEAL NO.: 2007-0417

TITLE: CAPACITIVE ELECTROSTATIC PROCESS FOR INHIBITING THE FORMATION
OF BIOFILM DEPOSITS IN MEMBRANE-SEPARATION SYSTEMS

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
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CERTIFICATE OF EFS-WEB TRANSMISSION

I hereby certify that on this 11th day of July, 2007, this correspondence is being transmitted to the U.S. Patent and Trademark Office: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



Alice Vanicek

TO THE COMMISSIONER FOR PATENTS

REQUEST FOR REHEARING

Dear Sir:

This is in response to the Decision on Appeal dated 11 May 2007.

The Appellants respectfully request rehearing of the subject Decision On Appeal because the board has misapprehended or overlooked the following two points of fact and law.

Appellants Have Made Reference to All Priority Applications in the Specification

On Page 7 of the Decision on Appeal, the Board states that "The present application does not refer to the other applications in the priority chain, including Pitts." The Board is in error on this point, as the Appellants filed an amendment to the first paragraph of their specification on May 11, 2005. This amendment replaced the first paragraph to include all applications from which priority was claimed, including Pitts. The entry of this amendment was acknowledged by the Examiner in paragraph 1 on page 2 of the Office Action dated August 8, 2005 ("The amendment to the first page of the specification establishes a priority chain back to February 16, 1994, the filing date of application 08/197,154 [Pitts]"). Accordingly, the Appellants' disclosure does in fact contain the "specific reference" to all applications in the priority chain as required by *Sticker Indus. Supply Corp. v. Blaw-Knox Co.*, 405 F.2d 90, 92-93, 160 USPQ 177, 178-179 (7th Cir. 1968).

Each Application in the Priority Chain Contains Pitts' Electro-Static Field Generator Disclosure

On Page 6 of the Decision on Appeal, the Board states the following:

Here, the Appellants may have established that Pitts inherently describes the subject matter claimed in the present application within the meaning of 35 U.S.C. §112, first paragraph. But, the Appellants have not demonstrated that each application in the chain inherently describes the subject matter claimed in the present application or contains Pitts' *inherent disclosure relied upon by the Examiner* (Br. 4-6 and Reply Br. 2-3; emphasis added).

The italicized portion of Board's second sentence implies that the Examiner's decision to not recognize the Appellants' priority claim is based in part on the failure of the Appellants to prove that each priority application "contains Pitts' inherent disclosure relied upon by the Examiner." The Appellants respectfully submit that the Examiner has never questioned whether the priority chain of applications describes "Pitts' inherent disclosure" of the electrostatic-field generator. Answer at p. 4, lines 7-9 ("While the '154 patent [sic] discloses the same electrostatic-field generator used in the instant method, the '154 application does not disclose a method for reducing the formation of biofilm deposits on a wall in a water system."). In other words, the Examiner has never disputed that the electrostatic-field generator apparatus used in the method claims of the present application has continually been disclosed without hiatus. Indeed, as the file wrapper history shows, every single priority application contains the same description of the electrostatic-field generator used in the case now on appeal.

Instead, the Examiner contends that several prior applications (including Pitts) do not disclose a method for reducing the formation of biofilm deposits on a wall in a water system using the electrostatic-field generator (see Answer at p. 4, lines 7-14). Thus, according to the record before the Board, the issue of whether Pitts is available as "prior art" must be based solely on the Examiner's contention that Pitts' disclosure of the subject electrostatic-field generator is insufficient for priority to be recognized for claims to a method using said generator to effect reduction of a biofilm. Stated another way, the only question raised by the Examiner in his denial of priority has been whether the Appellants' instant claims are sufficiently supported, within the meaning of 35 U.S.C. §120, by the disclosure of the electrostatic-field generator apparatus of Pitts.

The very fact the Examiner admits that "the use of the electrostatic-field generator disclosed and claimed in the '317 patent [Pitts] is considered to necessarily result in reducing the formation of biofilm deposits" (Answer at page 4) argues that one skilled in the art would "necessarily" practice the claimed method invention simply by using the electrostatic-field generator of Pitts. Hence, the written description portion of 35 U.S.C. §120 is satisfied because Pitts inherently describes the subject method claimed in the present application.

Indeed, case law cited by the Board in the Decision on Appeal states that a later application claiming an inherent feature of a product is entitled to priority of the earlier product application. *Kennecott Corporation v. Kyocera International, Inc.*, 835 F.2d 1419, 1423, 5 U.S.P.Q.2d 1194 Fed. Cir., 1987) ("The disclosure in a subsequent patent application of an inherent property of a product does not deprive that product of the benefit of an earlier filing date."); See also *Technicon Instruments Corp. v. Coleman Instruments, Inc.*, 255 F.Supp 630, 640-641, 150 USPQ 227, 236 (N.D. ILL 1966) ("By disclosing in a patent application a device that inherently performs a function, operates according to a theory, or has an advantage, a patent applicant necessarily discloses that function, theory, or advantage even though he says nothing concerning it.").

Because Pitts discloses a generator that, according to the Examiner, "inherently" performs the claimed biofilm-reduction method limitation, the written description requirement is inherently satisfied in all subsequent applications that disclose the same generator. Accordingly, it is clear error to deny priority dating back to Pitts because, on the record before the Board, the Examiner

has never disputed that every application in the priority chain (including Pitts) discloses an electrostatic-field generator that inherently performs the claimed bio-film reduction function.

In view of the foregoing, the Appellants respectfully submit that rehearing and reversal of the rejections is warranted.

No fee is believed to be due with this Request. Should there be any unforeseen fees due, please charge our deposit account 170055.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'G. Milczarek-Desai', with a stylized, cursive script.

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